

## REMARKS

In an Office Action mailed on November 16, 2005, an objection was made to the drawing; objections were made to claims 16, 19 and 32; claims 22-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Huber; claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boynton in view of Huber; claims 16-19, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Huber; claim 6-15, 20 and 21 were allowed; and an objection was made to claim 2 as being dependent upon a rejected base claim but was indicated as being allowable if rewritten in independent form.

Applicant hereby submits a replacement and annotated sheet for Fig. 11 to overcome the objection to the drawing. Claims 16, 19 and 32 have been amended to overcome the corresponding claim objections. Independent claim 1 has been amended to incorporate the limitations of claim 2. For at least the reason that the Examiner indicated that claim 2 as allowable if rewritten in independent form, allowance of claims 1 and 3-5 is requested. Newly-added claim 33 depends from claim 16 and is patentable for at least the same reasons as claim 16, for the reasons that are discussed below. The §§ 102 and 103 rejections are addressed below.

### § 103 Rejections of Claims 16-19:

As amended, the tool string connector of independent claim 16 includes a tubular body that has two open ends. The tubular body has a plurality of slots that are formed therein to reserve space for axial deflection of the tubular body in response to a compressive force. The tubular body is connected to a first downhole tool. The tool string connector also includes a tapered element that is formed on one end of the tubular body. The tapered element is formed to engage with a mating tapered element on a second downhole tool.

Contrary to the limitations of amended independent claim 16, Smith discloses slips 20. As depicted in Figs. 2 and 3 of Smith, the slips 20 do not individually or collectively form a tubular body. In this regard, each slip 20 only partially circumscribes the longitudinal axis of Smith's connector, and the slips 20 are not connected together to form an overall tubular body. Thus, a longitudinal gap exists between each slip 20. Therefore, for at least the reason that the slips 20, individually or collectively, fail to disclose a tubular body that has a plurality of slots, Smith fails to disclose the tubular body of claim 16.

Furthermore, Smith fails to disclose the tubular body of independent claim 16 for at least the reason that even assuming, for purposes of argument, that the slips 20 may form a tubular

body that has longitudinal slots, this body does not contain a plurality of slots that reserve space for axial deflection of the tubular body. Therefore, for at least this additional, independent reason, Smith fails to disclose the tubular body of claim 16.

Huber fails to teach or suggest the missing claim limitations. Therefore, for at least the reason that the hypothetical combination of Smith and Huber fails to teach the limitations of amended independent claim 16, allowance of this claim is requested.

Claims 17-19 and 33 are patentable for at least the reason that these claims depend from an allowable claim.

#### § 102 Rejections of Claims 22-24:

The method of independent claim 22 includes connecting two downhole tools in series by compressing the sleeve and rotating one into threaded engagement with the other tool. As amended, the method includes locking the tools together by decompressing the sleeve. The sleeve includes lugs to engage each tool to prevent the tools from rotating out of threaded engagement.

Contrary to the limitations of amended independent claim 22, Huber fails to teach or suggest locking tools together by decompressing a sleeve that includes lugs to engage each tool to prevent the tools from rotating out of threaded engagement. In this regard, Huber merely discloses a coiled spring that does not include such lugs. As such, Huber fails to teach or suggest the act of locking of amended independent claim 22.

Claims 23 and 24 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, for at least the reasons that are set forth above, allowance of claims 22-24 is requested.

§ 102 Rejections of Claims 25 and 26:

The method of independent claim 25 is for forming a tool string for use in well operations. The method includes compressing a sleeve that is arranged between two tools and rotating one tool into threaded engagement with the other tool. As amended, the method of independent claim 25 includes decompressing the sleeve to cause features of the sleeve to engage features of the tools to lock the tools together in a predetermined alignment.

Contrary to the limitations of amended independent claim 25, Huber fails to teach or even suggest decompressing a sleeve to cause features of the sleeve to engage features of the tools to lock the tools together in a predetermined alignment. Huber's coiled spring does not contain such features, and as such, Huber fails to teach the act of decompressing of claim 25.

Therefore, for at least the reasons that are set forth above, withdrawal of the § 103 rejections of claims 25 and 26 is requested.

§ 103 Rejections of Claims 31 and 32:

The apparatus of independent claim 31 includes an axially compressible body that is adapted to connect with one downhole tool and is adapted to be compressed to connect the downhole tools together. The tapered element is adapted to engage the other downhole tool.

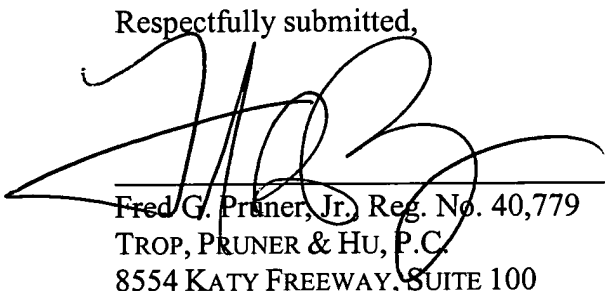
Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Huber. The Examiner refers to element 20 of Smith as being the alleged compressible body of independent claim 31. However, as pointed out above in the discussion of independent claim 16, each element 20 is a slip. There is no teaching or suggestion that the slips 20, individually or collectively, are axially compressible to hold two downhole tools together. Huber does not teach or suggest the missing claims limitations. Therefore, allowance of claims 31 and 32 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0281US).

Respectfully submitted,

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### DRAWINGS AMENDMENTS

Replacement and annotated drawing sheet for Fig. 11 are attached.



**FIG. 11**

